

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

)	Confirmation No.: 1646
)	
Appellant: HETTISH et al.)	Group Art Unit: 2443
)	
Application No.: 10/673,941)	Examiner: Mark D. Fearer
)	
Filing Date: 9/29/2003)	APPEAL BRIEF
)	
For: METHOD AND SYSTEM FOR)	Docket No.: 2003P08065US
SENDING A MESSAGE TO ONE)	
OR MORE DESTINATIONS)	PTO Customer Number 28524
)	
)	

Mail Stop APPEAL - PATENTS (via EFS)
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Appellant hereby appeals to the Board of Patent Appeals and Interferences from the decision of the Examiner in the Final Office Action mailed March 30, 2009 (the "Final Office Action"), rejecting claims 1 – 11, 13, and 15 – 24.

REAL PARTY IN INTEREST

The present application is assigned to Siemens Information and Communication Networks, Inc., 900 Broken Sound Blvd., Boca Raton, Florida 33487.

RELATED APPEALS AND INTERFERENCES

No other appeals or interferences are known to Appellant, Appellant's legal representative, or assignee, which will directly affect, be directly affected by, or have a bearing on the Board's decision in the pending appeal.

STATUS OF CLAIMS

All claims (i.e., claims 1 – 11, 13 and 15 – 24) are rejected and are being appealed.

STATUS OF AMENDMENTS

No amendments to the claims are pending or were filed after the Final Office Action.

SUMMARY OF CLAIMED SUBJECT MATTER INVOLVED IN THE APPEAL

Some embodiments of the present invention relate to a system, method, apparatus, and article of manufacture for sending a message to one or more different types of user destinations via an intermediary server or other device. FIG. 1 provides an overview of a system including a server 104, an application 102, and a number of user devices 106, 108, 110, 112 in communication therewith via a communications network 114. FIGS. 2 and 3 further disclose and illustrate aspects of the claimed methods of the invention, while FIG. 4 provides an illustrative depiction of a system in accordance with the claimed system.

Appellant will now map each of the independent claims, and the dependent claims that are argued separately, to the disclosure of this application.

Claim 1

Claim 1 recites a method, comprising:

receiving a request from an application to provide an outgoing message to a destination address, said request including data indicative of a message, said destination address, and an outgoing message type (FIG. 2, 152; and pg. 5, ln. 25 – pg. 6, ln. 16), wherein said data indicative of a message, said destination address, and said outgoing message type are not all received in the same request at a same time (pg. 9, ln. 22 – 25);

converting said message to said outgoing message in a format compatible with said outgoing message type, said outgoing message format being a different format than the message (FIG. 2, 154; and pg. 7, ln. 27 – pg. 8, ln. 9);

sending said outgoing message to said destination address (FIG. 2, 156; and pg. 8, ln. 10 – 22); and

providing, in reply to said request, a response to said application indicative of a success of said sending of said outgoing message to said destination address (pg. 8, ln. 23 – pg. 9, ln. 21).

Claim 18

Claim 18 recites a method, comprising:

establishing a protocol to receive a request to provide an outgoing message to destination address, wherein said protocol includes parameters for said destination address and said outgoing message type;

receiving said request from an application to provide an outgoing message to a destination address, said request being compliant with said protocol and including data indicative of a first message, a first destination address, and a first outgoing message type (FIG. 2, 152; and pg. 5, ln. 25 – pg. 6, ln. 16), wherein said data indicative of a

message, said destination address, and said outgoing message type are not all received in the same request at a same time (pg. 9, ln. 22 – 25);

converting said first message to said outgoing message in a format compatible with said first outgoing message type, said outgoing message format being a different format than said first message (FIG. 2, 154; and pg. 7, ln. 27 – pg. 8, ln. 9);

sending said outgoing message to said first destination address(FIG. 2, 156; and pg. 8, ln. 10 – 22); and

providing, in reply to said request, a response to said application indicative of a success of said sending of said outgoing message to said destination address (pg. 8, ln. 23 – pg. 9, ln. 21).

Claim 23

Claim 23 recites an article of manufacture comprising:

a computer readable medium having stored thereon instructions which, when executed by a processor, cause said processor to:

receive a request from an application to provide an outgoing message to a destination address, said request including data indicative of a message, said destination address, and an outgoing message type (FIG. 2, 152; and pg. 5, ln. 25 – pg. 6, ln. 16), wherein said data indicative of a message, said destination address, and said outgoing message type are not all received in the same request at a same time (pg. 9, ln. 22 – 25);

convert said message to said outgoing message in a format compatible with said outgoing message type, said outgoing message format being a different format than the message (FIG. 2, 154; and pg. 7, ln. 27 – pg. 8, ln. 9);

send said outgoing message to said destination address (FIG. 2, 156; and pg. 8, ln. 10 – 22); and

provide, in reply to said request, a response to said application indicative of a success of said sending of said outgoing message to said destination address (pg. 8, ln. 23 – pg. 9, ln. 21).

Claim 24

Claim 24 recites a system, comprising:

a processor;

a communication port coupled to said processor and adapted to communicate with at least one device; and

a storage device coupled to said processor and storing instructions adapted to be executed by said processor to:

receive a request from an application to provide an outgoing message to a destination address, said request including data indicative of a message, said destination address, and an outgoing message type (FIG. 2, 152; and pg. 5, ln. 25 – pg. 6, ln. 16), wherein said data indicative of a message, said destination address, and said outgoing message type are not all received in the same request at a same time (pg. 9, ln. 22 – 25);

convert said message to said outgoing message in a format compatible with said outgoing message type, said outgoing message format being a different format than the message (FIG. 2, 154; and pg. 7, ln. 27 – pg. 8, ln. 9);

send said outgoing message to said destination address (FIG. 2, 156; and pg. 8, ln. 10 – 22); and

provide, in reply to said request, a response to said application indicative of a success of said sending of said outgoing message to said destination address (pg. 8, ln. 23 – pg. 9, ln. 21).

GROUND OF REJECTION TO BE REVIEWED ON APPEAL

Whether claims 1 – 11, 13, and 15 – 24 are unpatentable under 35 USC 103(a) as being obvious over Lewis, U.S. Publication No. 2003/0110212 A1 (“Lewis”) in view of Hashimoto et al., U.S. Patent No. 6,397,282 B1 (“Hashimoto”).

ARGUMENT

I. Applicable Law

All of the issues in this appeal are related to rejections under 35 U.S.C. § 103(a), in which the Examiner contends that the claims are obvious on the grounds that all of the limitations of such claims are taught by a combination of the references asserted in the Final Office Action.

The recent Supreme Court decision in *KSR Int'l Co. v. Teleflex Inc.*¹ is now the leading case on obviousness.

Prior to the decision in *KSR*, the prevailing rule, as stated in *In re Royka*², was that a *prima facie* finding of obviousness cannot properly be made unless all the limitations of the claimed invention are taught or suggested by the prior art.

KSR did not explicitly modify that rule. However, that no longer appears to be the rule set forth in the MPEP.

Notwithstanding the change in position of the MPEP, Appellant respectfully submits that in regard to the rejections that are now under appeal, where the Examiner appears to assert that the claims are obvious because a combination of prior art references teaches all of the limitations of such claims, it would seem to reason that the rejections have not set forth a *prima facie* case of obviousness and thus can not stand unless the proposed combination of prior art references does indeed teach or suggest all of the limitations of the claims.

¹ 127 S.Ct. 1729, 82 USPQ2d 1385 (2007)

² 490 F. 2d 981 (CCPA 1974)

As will be seen, the essence of some of the arguments set forth herein is that the combination of references proposed in the Final Office Action fail to disclose all of the limitations set forth in the independent claims now on appeal.

The law as to considering evidence or arguments submitted by Appellant is as set forth in *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992), which states that after evidence or argument is submitted by the Appellant in response, patentability is determined on the totality of the record, by a preponderance of evidence with due consideration to persuasiveness of argument.

As will be seen, the essence of some of the arguments set forth herein is that the Examiner has failed to determine patentability on the totality of the record, by a preponderance of evidence.

II. Claims 1 – 11, 13, and 15 – 24 are Patentable

Claim 1 relates to receiving a request from an application to provide an outgoing message to a destination address, the request including data indicative of a message, the destination address, and an outgoing message type, wherein the data indicative of a message, the destination address, and the outgoing message type are not all received in the same request at a same time; converting the message to the outgoing message in a format compatible with the outgoing message type, the outgoing message format being a different format than the message; sending the outgoing message to the destination address; and providing, in reply to the request, a response to the application indicative of a success of the sending of the outgoing message to the destination address. Thus, it is clear that the claimed data indicative of a message, the destination address, and the outgoing message type are not all received in the same request at a same time.

Appellant notes the Office cites and relies upon Lewis for allegedly disclosing the claimed aspect of, “receiving a request from an application to provide an outgoing message to a destination address, the request including data indicative of a message, the destination address, and an outgoing message type”, however the rejection is silent

regarding, in particular, the claimed request from an application including data indicative of an outgoing message type. It is noted that the Final Office Action does cite Lewis, paragraph [0107], but Lewis in fact fails to disclose or suggest receiving a request from an application to provide an outgoing message where the request includes the outgoing message type. Instead, Lewis discloses,

[0107] The messaging interface 210 communicates with the processor 220. Regarding messages incoming from the messaging interface 210, the processor 220 operates to translate messages between the messaging element 205 format or protocol and the common format utilized on the network transport bus 125. In addition, the processor 220 generates routing requests to a router, generally a RAVE 130. In order to generate a routing request, the processor 220 may, for example, parse the incoming message from the message interface 210 to retrieve an originating address and a destination address from the incoming message. The routing request generated by processor 220 may include the origination address, destination address, and a unique transaction identification that identifies the message. The processor 220 receives a routing response via the network transport bus interface 230 that contains routing information for the received message. Based on that routing response, the processor 220 operates to route messages received from the messaging interface 210 to an appropriate destination. (emphasis added)

Since paragraph [0107] is the only portion of Lewis noted for allegedly disclosing the claimed aspect of the request to provide an outgoing message includes the outgoing message type, it is clear that Lewis fails to disclose or even suggest this aspect of the claims. Further, Lewis translates messages to “the common format utilized by the network transfer bus”. As such, there is no need or reason for Lewis to even be notified of the outgoing message type in an incoming message since all messages are translated to a common message type, as specifically stated by Lewis. Lewis is contrary to the pending claims where the message is converted into a format compatible with the received and specified outgoing message type.

Regarding the Office’s acknowledgement that Lewis does not disclose that the claimed aspect of the request “data indicative of a message, the destination address, and the outgoing message type are not all received in the same request at a same time”, the Office cites and relies upon Hashimoto. However, Hashimoto fails to disclose

or suggest this aspect of the claims for which it is cited and relied upon for disclosing. Despite the Office's final rejection and arguments, Hashimoto actually discloses,

To address the above-mentioned problem, a communication controller of an embodiment of the invention comprises a storage for storing the data of the message being received, a determining unit for determining types of message being received, and a transmission controller for generating interruption requests at different timing for transferring data to the data processor responsive to the determining unit.

According to an embodiment of the present invention, interruption requests to transfer data are generated at different timing according to the types of the message. That is, for instance, an interruption request is generated immediately for the message of the type which requires urgency. An interruption request is generated by another criteria relative to a message which is not urgent. Therefore, data which requires urgency is transferred to a data processor speedily without interrupting the data processor too frequently. Thus, an efficient system operation is achieved.

In accordance with one aspect of the invention, in a computer system having a data processor and a communication controller that controls data reception to the data processor, the communication controller comprises a storage for storing data of a received message, a determining unit for determining whether the received message requires immediate processing or not, and a transmission controller for generating an interruption request to transfer data stored in the storage in response to a determination by the determining unit that the message received requires immediate processing, wherein when interruption takes place, data in the storage, which have been stored by that time and are yet to be transferred, are transferred to the data processor. (emphasis added)

Therefore, based on the explicit disclosure of Hashimoto, it is clear that Hashimoto relates to the "transfer" of data that has been previously stored and not yet transferred. Interruption requests to transfer the stored data are generated at different times according to the type of message. In this manner, Hashimoto transfers complete messages at different rates depending on the urgency of the message as indicated by the type of message being transferred. Hashimoto does not disclose the transfer of different associated message components at different times.

Appellant respectfully submits that the present application relates to "converting the message to the outgoing message in a format compatible with the outgoing message type, the outgoing message format being a different format than the message"

and “the destination address, and the outgoing message type are not all received in the same request at a same time” . (emphasis added) The claimed converting of a message to a format compatible with the received outgoing message type is not the same as Hashimoto’s transferring of messages at different rates (i.e., urgency) based on the type of the message. Additionally, the Hashimoto’s “transfer” of messages at different rates based on the urgency of the message as indicated by the message type is not the same as or equivalent to the claimed aspect of not receiving the message, the destination address, and the outgoing message received in the same request at a same time. The transfer of previously stored messages is not the same as the receiving of different portions of a request at different times. Therefore, Hashimoto fails to disclose that which is claimed by Appellant.

Furthermore, Appellant respectfully submits that the combination of Lewis and Hashimoto fails to disclose or even suggest the pending claims since the Lewis/Hashimoto combination fails to compensate for the lack of required disclosure in each of the cited and relied upon references. That is, the combination of Lewis and Hashimoto fails to disclose or even suggest the claimed aspect of the request to provide an outgoing message includes the outgoing message type and the claimed aspect of data indicative of a message, the destination address, and the outgoing message type are not all received in the same request at a same time”.

Accordingly, Appellant respectfully submits claim 1 is not rendered obvious by Lewis and Hashimoto, the Office has not made out a *prima facie* case of obviousness under 35 U.S.C. § 103, and the rejection of claim 1 should be reversed. The remaining claims 2 – 11, 13, and 15 – 24 depend from claim 1 (or contain similar limitations) and should therefore be allowable for at least the same reasons.

CONCLUSION

For at least the reasons set forth above, Appellant respectfully submits that the rejection of the claims is improper. Accordingly, Appellant respectfully requests that the rejection be reversed.

No extension of time is believed due. The requisite fee of \$540.00 is paid herewith through EFS. If any additional fees are due in conjunction with this matter, the Commissioner is hereby authorized to charge them to Deposit Account 50-1852.

An Appendix of claims involved in this appeal is attached hereto.

If any issues remain, or if the Examiner or Board believes that a telephone interview would expedite the prosecution of this application in any way, kindly contact the undersigned via telephone at (203) 972-5985.

Respectfully submitted,

October 23, 2009
Date

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APPENDIX A - CLAIMS

1. (Previously Presented) A method, comprising:

receiving a request from an application to provide an outgoing message to a destination address, said request including data indicative of a message, said destination address, and an outgoing message type, wherein said data indicative of a message, said destination address, and said outgoing message type are not all received in the same request at a same time;

converting said message to said outgoing message in a format compatible with said outgoing message type, said outgoing message format being a different format than the message;

sending said outgoing message to said destination address; and

providing, in reply to said request, a response to said application indicative of a success of said sending of said outgoing message to said destination address.

2. (Original) The method of claim 1, further comprising:

establishing a protocol for receiving data indicative of a message to be sent to a destination address.

3. (Original) The method of claim 2, wherein said protocol includes parameters for outgoing message type and destination address.

4. (Original) The method of claim 2, wherein said protocol includes

parameters for incoming message type and sender address.

5. (Original) The method of claim 2, wherein said protocol includes a parameter for a service provider to be used to send said outgoing message.

6. (Original) The method of claim 2, wherein said protocol includes a parameter for a maximum size of said outgoing message.

7. (Original) The method of claim 1, wherein said data is indicative of an address associated with a sender of said message.

8. (Original) The method of claim 1, wherein said data is indicative of a service provider to use in said sending said outgoing message to said destination address.

9. (Original) The method of claim 8, wherein said sending said outgoing message to said destination address includes sending said outgoing message to said destination address via said server provider.

10. (Original) The method of claim 1, wherein said data is indicative of a maximum size for said outgoing message.

11. (Original) The method of claim 10, wherein said converting said message to an outgoing message in a format compatible with said outgoing message type includes converting said message into said outgoing message such that said outgoing message does not exceed said maximum size.

12. (Cancel)

13. (Original) The method of claim 1, further comprising:

 sending a response message to said application, said response message being indicative of an error in delivery of said outgoing message to said destination address.

14. (Cancel)

15. (Original) The method of claim 1, further comprising:

 determining that said outgoing message was not delivered to said destination address.

16. (Previously Presented) The method of claim 1, wherein said receiving a request from an application includes receiving said data in accordance with a pre-established protocol.

17. (Original) The method of claim 1, further comprising:

establishing a protocol indicative of how to send a message to a sender of said data.

18. (Previously Presented) A method, comprising:

establishing a protocol to receive a request to provide an outgoing message to destination address, wherein said protocol includes parameters for said destination address and said outgoing message type;

receiving said request from an application to provide an outgoing message to a destination address, said request being compliant with said protocol and including data indicative of a first message, a first destination address, and a first outgoing message type, wherein said data indicative of a message, said destination address, and said outgoing message type are not all received in the same request at a same time;

converting said first message to said outgoing message in a format compatible with said first outgoing message type, said outgoing message format being a different format than said first message;

sending said outgoing message to said first destination address; and

providing, in reply to said request, a response to said application indicative of a success of said sending of said outgoing message to said destination address.

19. (Previously Presented) The method of claim 18, wherein said protocol includes parameters for incoming message type and sender address.

20. (Previously Presented) The method of claim 18, wherein said protocol includes a parameter for a service provider to be used to send said outgoing message.

21. (Previously Presented) The method of claim 18, wherein said protocol includes a parameter for a maximum size of said outgoing message.

22. (Previously Presented) The method of claim 18, wherein said protocol includes at least one parameter for providing data to said application indicative of an error in delivery of said outgoing message to said destination address.

23. (Previously Presented) An article of manufacture comprising:

a computer readable medium having stored thereon instructions which, when executed by a processor, cause said processor to:

receive a request from an application to provide an outgoing message to a destination address, said request including data indicative of a message, said destination address, and an outgoing message type, wherein said data indicative of a message, said destination address, and said outgoing message type are not all received in the same request at a same time;

convert said message to said outgoing message in a format compatible with said outgoing message type, said outgoing message format being a different format than the message; and

send said outgoing message to said destination address; and

provide, in reply to said request, a response to said application indicative of a success of said sending of said outgoing message to said destination address.

24. (Previously Presented) A system, comprising:

a processor;

a communication port coupled to said processor and adapted to communicate with at least one device; and

a storage device coupled to said processor and storing instructions adapted to be executed by said processor to:

receive a request from an application to provide an outgoing message to a destination address, said request including data indicative of a message, said destination address, and an outgoing message type, wherein said data indicative of a message, said destination address, and said outgoing message type are not all received in the same request at a same time;

convert said message to said outgoing message in a format compatible with said outgoing message type, said outgoing message format being a different format than the message; and

send said outgoing message to said destination address; and
provide, in reply to said request, a response to said application indicative of a success of said sending of said outgoing message to said destination address.

APPENDIX B - EVIDENCE

No evidence is being submitted with this Appeal Brief (*i.e.*, this appendix is empty).

APPENDIX C - RELATED PROCEEDINGS

No prior or pending appeals, interferences, or judicial proceedings are known to Appellant, Appellant's legal representative, or assignee, which may be related to, directly affect, be directly affected by, or have a bearing on the Board's decision in the pending appeal. Therefore, there are no copies of decisions rendered by a court or the Board to attach (*i.e.*, this appendix is empty).